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REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
GROUP 2681
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q62357

Yves LE GENDRE, et al.

Appln. No.: 09/739,305

Group Art Unit: 2681

Confirmation No.: 3328

Examiner: Erika A. GARY

Filed: December 19, 2000

For: A METHOD OF OBTAINING INFORMATION ON THE IDENTITY OF A CALLER IN
A TERMINAL OF A TELEPHONE COMMUNICATIONS NETWORK

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APR 12 2004

Technology Center 2600

Sir:

In response to the Office Action dated January 8, 2004, reconsideration and allowance of the subject application are respectfully requested. Upon entry of this Amendment, claims 1-14 are pending in the application. In response to the Office Action (Paper No. 6), Applicant respectfully submits the pending claims define patentable subject matter.

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DeFazio et al. (U.S. Patent No. 5,940,484; hereafter "DeFazio") in view of newly cited Grube et al. (U.S. Patent No. 5,557,605; hereafter "Grube"). Applicant respectfully submits that the claimed invention would not have been rendered obvious in view of DeFazio and Grube.

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Independent claim 1 is directed to “[a] method of obtaining information regarding an identity of a caller in a terminal of a telephone communications network, wherein the terminal comprises an agent including a program or an application which is stored and activated on the terminal.” Claim 1 recites:

receiving at the terminal an incoming call from a caller and a telephone number of the caller;

selecting at the agent of the terminal at least one external server likely to be able to provide the information regarding the identity of the caller;

preparing at the agent of the terminal a request indicating the telephone number of the caller and requesting the information regarding the identity of the caller; and

sending from the agent of the terminal the request to the server.

Claim 7 is directed to a terminal of a telephone communications network and recites limitations similar to those in claim 1 in apparatus format.

With regard to independent claims 1 and 7, the Examiner alleges that DeFazio discloses all of the features of the claimed invention except for “the agent resides in the terminal and includes a program or an application that is stored and activated on the terminal”, which the Examiner contends is disclosed by Grube. Further, the Examiner asserts that “it would have been obvious to one of ordinary skill in the art to modify DeFazio to include Grube ... to allow the terminal to request the caller data as it is not always needed or desired ... [and because] it is known in the art to relocate one component’s functionality to another component.”

DeFazio discloses a self-provisioning names database which adds new names to a database for associating names to calling address data in a caller identification with name

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delivery service each time a new caller places a call to a service subscriber. As shown in Figure 1, a calling party 1 places a call through the public switched telephone network 2 and is ultimately connected to a local switch 3 serving a called subscriber 4 having a telephone and an associated caller identification display unit 4a. A number to name translation database 5 is communicably linked to the local switch 3. A national or other names database 6 is communicably linked to the names database 5. When the calling party 1 initiates a call to the called subscriber 4, the local switch (or private branch exchange switch) provide a name associated with the telephone number of the calling party 1. The database 5 queries itself, and if no name is found, initiates a further query to national database 6. If a name is found in the database 5 or the national database 6, the name is provided to the called subscriber 4 when the call is connected to the called subscriber 4.

Grube discloses a method for providing caller data in a time division multiplexed (TDM) radio communication system. With reference to Figure 1, a source communication unit (mobile radio) 101 transmits a voice message to a target communication unit (mobile radio) 103 via over a RF carriers 107, 108. The target mobile radio 103 transmits a caller data request regarding the geographic location, heading, speed, and/or radio status (i.e., remaining battery life, service capabilities or warranty information) of the source mobile radio 101. The caller data request can be sent directly to the source mobile radio 101 or to a central controller 106 which can store and gather data relating the geographic location, heading, speed, and/or radio status of the source mobile radio 101. The requested caller data is then included with a subsequent voice message transmission to the target mobile radio 103.

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Applicant respectfully submits that the cited references do not teach or suggest all of the features of the claims and one of ordinary skill in the art would not have been motivated to modify the names database telephone system of DeFazio based on the mobile radio system of Grube to include the claimed agent in the terminal such that all operations regarding selection the external server and preparation and transmission of the request for the information regarding the identity of the caller are performed at the terminal receiving the incoming call.

First, nowhere does Grube teach or suggest sending from the target mobile radio a request for information regarding the identity of the source mobile radio. Rather, Grube teaches sending from the target mobile radio a caller data request for information regarding the geographic location, heading, speed, and/or radio status of the source mobile radio. As discussed in the "Background of the Invention" section of Grube, it is known in the art to add source identity information (push-to-talk identification and/or alias name) to the beginning of a message from the source mobile radio to the target mobile radio. Thus, Grube is concerned with obtaining additional information from the source mobile radio such as the geographic location, heading, speed, and/or radio status of the source mobile radio. However, such additional information is not a concern or even applicable to a standard telephone network such as DeFazio.

Second, Grube is directed to a mobile radio system rather than a telephone network (i.e., communications between mobile two-way radios which are alternately transmitting and receiving with each other rather established call between telephone terminals). Thus, the mobile radio system of Grube and the telephone network of DeFazio utilize different network architectures and communication protocols. As a result, the context of Examiner's alleged "motivation for this

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combination, as suggested by Grube”, i.e., “to allow the terminal to request the caller data as it is not always needed or desired”, is also related to a facet of mobile radio system which is not a concern in telephone networks such as DeFazio. In particular, in mobile radio systems, each transmitted message is treated as a distinct communication which is allocated a communication resource (channel) for a one time use (i.e., a single continuous communication channel is not established between the mobile radios). On the other hand, in telephone communications, once a call is established, bi-directional communications are continuous until the call is terminated by either party. Thus, Grube’s statement regarding the “ability to indicate if the caller data is even desired” (at column 1, lines 31-39) is related to the case where two mobile radio are continuously transmitting and receiving with each other such that there is no need to repeatedly identify the transmitting mobile radio. However, this situation would not occur in a telephone network due to the nature of the communications (i.e., no series of calls back and forth between the parties).

Lastly, Applicant respectfully submits there is no basis for the Examiner’s conclusion that “it would have been obvious to one of ordinary skill in the art to modify DeFazio to include Grube ... [because] it is known in the art to relocate one component’s functionality to another component.” To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, there must be some suggestion or motivation to modify or combine the reference teachings.¹ The characterization of certain limitations or parameters as obvious does not make the claimed

¹ “To support the conclusion that the claimed invention is directed to obvious subject matter, either references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference.” *Ex parte Clapp* 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

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invention, considered as a whole, obvious. It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Accordingly, Applicant respectfully submits that claims 1-14 should be allowable because the cited references do not teach or suggest all of the features of the claims and one of ordinary skill in the art would not have been motivated to combine and modify the teachings of the cited references to produce the claimed invention.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: April 8, 2004

Attorney Docket No.: Q62357